

REMARKS

I. Status of the Application

Claims 1-32 are pending in this application with new claims 33-36 to be entered.

In the July 12, 2005 Office action, the Examiner:

- (i) objected to claims 21 and 32 for allegedly being duplicate claims;
- (ii) rejected claims 1, 4, 7, 13, 17, 20-22, 25, 28 and 32 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. patent No. 4,588,095 to Mehra (hereinafter “Mehra”);
- (iii) rejected claims 1-2, 4, 7, 13-17, 20-23, 25, and 28-32 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. patent No. 4,060,457 to Iizuka et al. (hereinafter “Iizuka”) in view of Mehra;
- (iv) rejected claims 15 and 31 under 35 U.S.C. § 103(a) as allegedly being obvious over Iizuka, as above, and further in view U.S. patent No. 5,950,832 to Pearlman (hereinafter “Pearlman”);
- (v) objected to claims 3, 5-6, 18-19 and 24-27 as being dependent upon a rejected base claim, but noted that claims 3, 5-6, 18-19 and 24-27 would be allowable if re-written in independent form; and
- (vi) allowed claims 8-12.

In this response, Applicant respectfully traverses the Examiner’s objection to claims 21 and 32. In addition, Applicant respectfully traverses the Examiner’s rejection of claims 1, 2, 4, 7, 13-17, 20-23 and 28-32 under 35 U.S.C. § 103(a). Finally, Applicant has added new claims 33-36.

II. The Objection to Claims 21 and 32 Should be Withdrawn

In the July 12, 2005 office action, the Examiner objected to claims 21 and 32 as allegedly being essentially duplicate claims, with the only difference in the claims being the preamble. Applicant respectfully submits that these claims are not duplicate claims, and differences exist in the claims other than in the preamble. In particular, claim 21 includes the following limitation: “wherein *the plurality of seats* are comprised of an electrically conductive plastic material” (emphasis added). By contrast, claims 32 includes the following limitation: “wherein *the tip rack* is comprised of an electrically conductive plastic material” (emphasis added). Because of these different limitations, the claims are different in scope. Thus, the Examiner’s objection to claims 21 and 32 as allegedly being essentially duplicate claims, with the only difference being the preamble, should be withdrawn.

III. The Rejection of Claims 1, 13, 21 and 32 should be Withdrawn

In the July 19, 2005 Office action, the Examiner rejected claims 1, 13, 21 and 32 under 35 U.S.C. § 103(a) as being obvious and unpatentable over either Mehra or Iizuka in view of Mehra. Applicants respectfully traverse the Examiner’s rejection of claims 1, 13, 21 and 32 under 35 U.S.C. § 103(a), as the Examiner has failed to make a *prima facie* case of obviousness as described in MPEP § 2142 - 2143.

In order to make a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. In this case, Applicant submits that at least one limitation from each of claims 1, 13, 21 and 32 is not suggested or taught by the prior art.

For example, with respect to claims 1, 13, 21 and 32 Applicant submits that at least the limitation that the tip rack comprises an “electrically conductive plastic material” is not disclosed in Mehra. In the July 12, 2005 Office action, the Examiner admitted that Iizuka does not describe the holder as being comprised of an electrically conductive plastic material (see p. 5, of the July 12, 2005 Office action). However, the Examiner noted that the device disclosed in Mehra may be made from various injection molding materials, such as polypropylene. The Examiner also noted that Mehra states that the injection molded material may also contain fillers including glass fibers, carbon black, carbon fibers and the like. The Examiner then concluded that “the carbon filled polypropylene is the same material as disclosed by Applicant as such the material inherently has the same properties and is considered to be an electrically conductive plastic material.” (See p. 6 of the July 12, 2005 Office action).

Applicant respectfully traverses the Examiner’s conclusion that the carbon filled polypropylene material in Mehra inherently has the same properties as that disclosed by Applicant and is considered to be “an electrically conductive plastic material.” In particular, most plastics include carbons, but most plastics are not electrically conductive. Carbon fillers may be added to plastic material for various reasons and in various associated concentrations. One widespread reason for adding carbon to injection molded materials is to enhance the mechanical properties of the component. For example, carbon fillers are well known to increase the flexural modulus of molded components, provide reinforcement for components, and generally improve the strength of molded components. Other reasons for adding carbon fillers to injection molded materials include improved processing, abrasion resistance, modified flow resistance, modified

specific weight and modified thermal expansion. In each case, the type, quality, amount and/or concentration of carbon fillers will determine the properties of the resulting material.

In view of the foregoing, Applicant respectfully submits that the mere disclosure in Mehra of polypropylene with carbon fillers is not a disclosure of an “electrically conductive plastic material.” In particular, many concentrations of carbon filler in polypropylene will not result in an electrically conductive material. Furthermore, the suggestion for adding fillers to the component disclosed in Mehra appears to be for the purpose of adding structural support to the component since Mehra discloses glass as the preferred filling material (see col. 10, lines 34-35), and glass as a filler enhances certain mechanical properties. There is no discussion in Mehra of the need or desire to provide a component with electrically conductive properties, and accordingly, there is no disclosure or suggestion in Mehra of a carbon filler concentration that would inherently provide an electrically conductive plastic material. Thus, Mehra does not disclose the limitation of “an electrically conductive plastic material” as found in each of claims 1, 13, 21 and 32, and the Examiner’s rejection of claims 1, 13, 21 and 32 should be withdrawn.

In further support of the above, Applicant respectfully notes that “obviousness cannot be established ... absent some teaching, suggestion or incentive supporting the combination.” *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). In addition, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present case, the mere fact that a combination of

polypropylene and carbon could comprise electrically conductive plastic material is not a disclosure of such an electrically conductive plastic material, and does not render an electrically conductive plastic material obvious, as there is no suggestion in Mehra of the desirability of such material. To the contrary, Mehra only seems to suggest the desirability of fillers for structural support (i.e., glass fibers are the preferred filling material)(see col. 10, lines 26-34). Therefore, there is no suggestion or motivation in the art cited by the Examiner for one of ordinary skill in the art to conclude that the injection molded rack of Mehra should be comprised of electrically conductive plastic material.

For at least the reasons discussed above, the Examiner has failed to make a *prima facie* case that claims 1, 13, 21, and 32 are unpatentable over either Mehra or Iizuka in view of Mehra. Accordingly, it is respectfully submitted that claims 1, 13, 21 and 32 are allowable and the Examiner's rejection of claims 1, 13, 21 and 32 as obvious over either Mehra, or Iizuka in view of Mehra, under 35 U.S.C. § 103(a) should be withdrawn.

IV. The Rejection of Claims 2, 4, 7, 14-17, 20, 22-23 and 28-31 Should be Withdrawn

As stated above, the rejection of claims 1, 13, and 21 under 35 U.S.C § 103(a) should be withdrawn. Each of claims 2, 4, 7, 14-17, 20, 22-23 and 28-31 depend from and incorporate all of the limitations of one of independent claims 1, 13, or 21. Accordingly, it is respectfully submitted that the Examiner's rejection of claims 2, 4, 7, 14-17, 20, 22-23 and 28-31 should also be withdrawn for at least the same reasons as independent claims 1, 13 and 21.

V. New Claims 33-36 Should be Allowed

Applicant has added new claims 33-36 which depend from independent claim 32. Each of these claims include additional limitations that distinguish the claim from the prior art. For example, claim 35 includes the limitation of “wherein the plurality of pipette tips that the seats are designed and dimensioned to hold are pipette tips configured for insertion on the pipettes of a multiple pipette device configured for use with a laboratory microplate.” Accordingly, claim 35 clearly limits the size of the seats. Neither Mehra nor Iizuka are “designed and dimensioned” to hold pipette tips. Instead, the disclosures of Mehra and Iizuka are directed to test tubes. The pipette tips specified in claim 35 would likely fall through the holes of the face of Mehra and Iizuka and would not be held within any seat disclosed in Mehra and Iizuka.

VI. Conclusion

For all of the foregoing reasons, it is respectfully submitted that the Examiner has not made a *prima facie* case of obviousness, and the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application, including pending claims 1-32 and new claims 33-36, is therefore respectfully requested.

Applicant has included a check in the amount of \$200.00 in payment of new claims 33-36. In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,



Russell E. Fowler II
Attorney Registration No. 43,615

Please address correspondence to:

Russell E. Fowler II
Maginot Moore & Beck
Bank One Center Tower
111 Monument Circle, Suite 3000
Indianapolis, Indiana 46204-5115

Telephone: (317) 638-2922
Facsimile: (317) 638-2139
Email: refowler@maginot.com

Enclosures: Check in the amount of \$200.00
Return Postcard